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BEST AVAILABLE COPY**I. THE CLAIMED INVENTION**

An exemplary embodiment of the claimed invention, as defined by, for example, independent claim 1, is directed to an opening/closing type portable information terminal equipped with a display portion housing having a display portion and an operating portion housing having an operating portion. An end portion of the display portion housing is linked to an end portion of the operating portion housing by a rotating mechanism under a state that a face of the display portion of the display portion housing is maintained to orient in a same side as a face of the operating portion of the operating portion housing so that the display portion housing is rotatable relative to the operating portion housing around the rotational axis of the rotating mechanism and so that the display portion housing swings through an arc that is substantially parallel to the face of the operating portion at a closed position. The rotational axis forms an acute angle with at least one of the face of the operating portion and the face of the display portion. Further, the display portion housing includes operating keys which are operable under a state that the display portion housing and the operating portion housing are closed.

Conventional portable terminal devices (like the terminal disclosed by the Kfoury reference) include a display portion that is rotatable with respect to the operating portion such that the two portions fold together and/or apart in a clam-shell like motion (col. 4, lines 53-57).

However, when these conventional terminal devices have been folded, the display portion cannot be seen and it is inconvenient for the user to repeatedly open and close the terminal to determine whether messages have been received and to review new messages.

Additionally, the operating keys for these conventional devices are not accessible

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when in a closed configuration, and therefore, these devices are not operable according to user interaction when in the closed configuration.

In stark contrast, the present invention provides a very simple structure that allows the display portion to rotate through an arc about a rotational axis that maintains an acute angle with at least one of the face of the operating portion and the face of the display portion where the display portion housing includes operating keys which are operable under a state that the display portion housing and the operating portion housing are closed.

In this manner, the present invention maintains the display portion in a visible and useable position regardless of whether the terminal is closed or open and further, enables the device to be used though the use of the operating keys on the display portion even while the terminal is closed.

II. THE PRIOR ART REJECTIONS

A. The Gray reference in view of the Narayanaswamy et al. reference

Regarding the rejection of claims 1, 4, 6, 8-9, and 13, the Examiner continues to allege that the Narayanaswamy et al. reference would have been combined with the Gray reference to form the claimed invention. Applicant submits, however, that these references would not have been combined as alleged by the Examiner.

First, Applicant notes that the Examiner has failed to comply with the clear requirements that are set forth in the Manual of Patent Examining Procedure. In particular, the Examiner has failed to comply with the requirements of the M.P.E.P. as set forth in § 707.07(f) by failing to answer all material traversed.

"Where the applicant traverses any rejection, the examiner should, if

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he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (M.P.E.P. § 707.07(f), emphasis added).

Specifically, at page 5, line 16 - page 6, line 13, in the Request for Reconsideration that was filed on May 17, 2006, the Applicant pointed out that one of ordinary skill in the art would not have been motivated to modify the telephone that is disclosed by the Gray reference to include operating keys which are operable when the telephone is closed based upon the disclosure of the Narayanaswamy et al. reference because such a modification would render the telephone configuration that is disclosed by the Gray reference useless for its intended purpose.

Clearly the Examiner has failed to address this traversal. Indeed, the Examiner does not mention anything at all regarding the fact that the Examiner's alleged combination would render the telephone of the Gray reference useless for its intended purpose.

M.P.E.P. § 2143.01.V. states:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (Emphasis added).

As explained previously, the intended purpose of the configuration that is disclosed by the Gray reference is "for protecting the keypad and/or controls from inadvertent contact and impact with objects in its vicinity, and also protecting the controls of the telephone from contamination by dust and other debris that might be present in its immediate environment." (Col. 1, lines 13 - 16, and col. 2, lines 25 - 31).

If one were to modify the telephone configuration that is disclosed by the Gray reference to include operating keys which are operable when the telephone is closed based

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upon the disclosure of the Narayanaswamy et al. reference, then the controls would no longer be protected from inadvertent contact and impact with objects in the vicinity and would also no longer be protected from contamination by dust and other debris, thereby rendering the telephone useless for its intended purpose.

Since the Examiner's alleged modification would render the telephone of the Gray reference useless for the intended purpose of protecting the keypad and/or controls, "then there is no suggestion or motivation to make the proposed modification." (Emphasis added, M.P.E.P. § 2143.01.V.).

Applicant notes that the Examiner does attempt to address the Applicants traversal of the obviousness rejection on the grounds that the applied references teaches away from the alleged combination.

In particular, the Examiner responds to this traversal by stating: "teaching a different way is not considered teaching away."

Even assuming that the Examiner's statement is correct, that statement is irrelevant to the Applicant's traversal. The Applicant never alleged that the fact that the Gray reference teaches a different way is considered a teaching away.

Rather, the Applicant traversed the rejection on the basis that the prior art as a whole does not suggest the desirability, and thus the obviousness of making the combination because the prior art as a whole specifically teaches away from making the alleged modification.

"[T]he proper inquiry is 'whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness of making the combination.'" (Emphasis original, M.P.E.P. § 2143.01.I.).

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In this regard, the Applicant is pointing out that the prior art as a whole teaches away from the alleged modification because the Gray reference criticizes, discredits, and discourages the Examiner's proposed modification.

“[T]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed.” (M.P.E.P. § 2143.01.I.).

In the present instance, the Gray reference specifically criticizes, discredits, and discourages the Examiner's alleged modification of including operation keys which are operable under a closed state because the Gray reference explains such exposure would allow “inadvertent contact and impact with objects in its vicinity” and risk exposure to “contamination by dust and other debris that might be present in its immediate environment.” (Col 2, lines 25 - 31).

Clearly, the Gray reference teaches away from exposing the operation keys to inadvertent contact and contamination by placing the these keys where they are operable when the device is in a closed state.

The applied references “as a whole [do not] suggest the desirability, and thus the obviousness of making the combination.” (M.P.E.P. § 2143.01.I.).

As explained previously, contrary to the Examiner's allegation, one of ordinary skill in the art would not have been motivated to modify the telephone that is disclosed by the Gray reference to include operating keys which are operable when the telephone is closed because the Gray reference teaches away from making such a modification and such a modification of the telephone would destroy the intended purpose of the telephone

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configuration that is disclosed by the Gray reference.

These references would not have been combined as alleged by the Examiner because the Gray reference teaches away from making the modification which the Examiner proposes.

**“References Cannot Be Combined Where Reference Teaches
Away from Their Combination”**

“It is improper to combine references where the references teach away from their combination.” (Emphasis original, M.P.E.P. § 2146.X.D.2).

The Gray reference discloses a portable wireless telephone having a swivel chassis. In particular, the Gray reference is concerned about “protecting the keypad and/or controls from inadvertent contact and impact with objects in its vicinity, and also protecting the controls of the telephone from contamination by dust and other debris that might be present in its immediate environment.” (Col. 2, lines 25 - 30).

In order to protect the keypad and/or controls from inadvertent contact and contamination by dust and other debris, the Gray reference discloses an “assembly that provides suitable protection for the operational components thereof while the telephone is being carried about by the person of the user” (col. 3, lines 6-11) and explains that this object is accomplished by providing a “surface 22 [that] will be the mating surface in closure and act as a perimeter barrier for a telephone keypad 24 or other control panel components which will preferably be sealed with respect to the second chassis section 14 to prevent entry of dust and other debris therein. The first chassis section 12 defines a rear surface 15 which corresponds with the configuration of the chassis surface 22 and, in the closed positions of the chassis sections, is disposed in close fitting, covering relation with the surface of panel 22 of the second chassis section to minimize contamination of the key pad 24 by dust and other

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debris." (Col. 6, lines 5-15).

In summary, the Gray reference teaches that it is important to cover the keypad and/or controls when in the closed position in order to protect the keypad and/or controls.

Clearly, the Gray reference teaches away from making the modification which the Examiner proposes to make to the device disclosed by the Gray reference.

Since the Gray reference teaches away from exposing the controls so that the controls are protected, the Examiner is not permitted to allege that one of ordinary skill in the art would have been motivated to expose the controls.

Secondly, contrary to the Examiner's allegation, one of ordinary skill in the art would not have been motivated to modify the telephone that is disclosed by the Gray reference to include operating keys which are operable when the telephone is closed based upon the disclosure of the Narayanaswamy et al. reference because such a modification would render the telephone configuration that is disclosed by the Gray reference useless for its intended purpose.

M.P.E.P. § 2143.01 states:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (Emphasis added).

As explained above, the intended purpose of the configuration that is disclosed by the Gray reference is "for protecting the keypad and/or controls from inadvertent contact and impact with objects in its vicinity, and also protecting the controls of the telephone from contamination by dust and other debris that might be present in its immediate environment." (Col. 1, lines 13 - 16, and col. 2, lines 25 - 31).

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If one were to modify the telephone configuration that is disclosed by the Gray reference to include operating keys which are operable when the telephone is closed based upon the disclosure of the Narayanaswamy et al. reference, then the controls would no longer be protected from inadvertent contact and impact with objects in the vicinity and would also no longer be protected from contamination by dust and other debris, thereby rendering the telephone useless for its intended purpose.

Further, Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, as explained above, the Gray reference is concerned with protecting operating keys from inadvertent contact and exposure to contaminants and the Kfoury reference is concerned with the completely different and unrelated problem of improving the adaptability of user interfaces in portable electronic devices allowing multi-mode operation and disability access while reducing manufacturing time and cost.

In stark contrast, the Narayanaswamy et al. reference is concerned with the completely different and unrelated problem of a limited display size (col. 1, lines 11-22).

One of ordinary skill in the art who was concerned with protecting operating keys from inadvertent contact and exposure to contaminants as the Gray reference is concerned, would not have referred to the Narayanaswamy et al. reference, and vice-versa, because the Narayanaswamy et al. reference is concerned with the completely different and unrelated problem of a limited display size. Thus, these references would not have been combined.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1, 4, 6, 8-9, and 13.

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B. The Gray reference in view of the Narayanaswamy et al. reference and further in view of the Kfoury reference

Regarding the rejection of claims 2-3, 5, 10-12, 14-16, 18, and 20-22, the Examiner continues to allege that the Narayanaswamy et al. reference would have been combined with the Gray reference and further alleges that the Kfoury reference would have been combined with the Narayanaswamy et al. reference and the Gray reference to form the claimed invention. Applicant submits, however, that these references would not have been combined.

As explained above, one having ordinary skill in the art would not have combined the Narayanaswamy et al. reference with the Gray reference as alleged by the Examiner because the Gray reference specifically teaches away from making such a modification and because such a modification would destroy the intended purpose of the Gray reference.

Further, Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

In stark contrast to the Narayanaswamy et al. reference and the Gray reference, the Kfoury reference is concerned with the completely different and unrelated problem of improving the adaptability of user interfaces in portable electronic devices allowing multi-mode operation and disability access while reducing manufacturing time and cost.

One of ordinary skill in the art who was concerned with protecting operating keys from inadvertent contact and exposure to contaminants as the Gray reference is concerned or who was concerned with the problem of a limited display size, as the Narayanaswamy et al. reference is concerned, would not have referred to the Kfoury reference because the Kfoury reference is concerned with the completely different and unrelated problem of improving the

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adaptability of user interfaces in portable electronic devices allowing multi-mode operation and disability access while reducing manufacturing time and cost. Thus, these references would not have been combined.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 2-3, 5, 10-12, 14-16, 18, and 20-22.

C. The Gray reference in view of the Narayanaswamy et al. reference and further in view of the Kfoury reference and yet in further view of the Lim reference

Regarding the rejection of claim 17, the Examiner continues to allege that the Narayanaswamy et al. reference would have been combined with the Gray reference and further alleges that the Kfoury reference would have been combined with the Gray reference and the Kfoury reference, and yet further alleges that the Lim reference would have been combined with the Kfoury reference, the Narayanaswamy et al. reference, and the Gray reference to form the claimed invention. Applicant submits, however, that these references would not have been combined.

Applicant notes that the Examiner again has failed to comply with the clear requirements that are set forth in the Manual of Patent Examining Procedure. In particular, the Examiner has failed to comply with the requirements of the M.P.E.P. as set forth in § 707.07(f) by failing to answer all material traversed.

"Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (M.P.E.P. § 707.07(f), emphasis added).

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Specifically, at page 9, line 17 - page 10, line 4, the Request for Reconsideration that was filed on May 17, 2006, the Applicant pointed out that one of ordinary skill in the art would not have been motivated to modify the telephone that is disclosed by the Gray reference based upon the disclosure in the Lim reference because the Lim reference operates based upon a principal of operation which is completely different from the devices that are disclosed by the Kfoury reference, the Narayanaswamy et al. reference, and the Gray reference.

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings are not sufficient to render the claims *prima facie* obvious." (M.P.E.P. § 2143.02.VI.).

In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), "The court reversed the rejection holding that 'suggested combination of reference would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle of operation under which the [primary reference] construction was designed to operate.'" (M.P.E.P. § 2143.02.VI.).

In the present instance, the Examiner admits that none of the Gray reference, the Narayanaswamy et al. reference, nor the Kfoury reference teaches or suggests "the operating portion comprises an inclined surface that is inclined at an angle of $(180 - \text{predetermined angle})/2$ with respect to the operating portion."

The Examiner then refers to the Lim reference in an attempt to remedy this deficiency.

Despite the apparent ability of the device that is disclosed by the Lim reference to

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meet this limitation, such a disclosure does not transform the structure of the device that is disclosed by the Gray reference in a manner which would enable that device to meet that limitation without requiring a significant modification of the joint structure.

The ability of the device disclosed by the Lim reference to meet this limitation is dependent upon the joint structure provided by the pair of fixing sections 30 and the rotating section 10.

Since the joint structure that is disclosed by the Gray reference is incapable of meeting this limitation, the joint structure of the Gray reference would need to be modified.

The Examiner's rejection, although not stated, can only be implying that one of ordinary skill in the art would have modified the joint of the device that is disclosed by the Gray reference such that it incorporates the joint that it is disclosed by the Lim reference.

Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to replace the joint in the telephone of the Gray reference with the joint that is disclosed by the Lim reference because such a modification "would require a substantial reconstruction and redesign of the elements shown in [the Gray reference] as well as a change in the basic principle under which the [Gray reference] construction was designed to operate." (M.P.E.P § 2143.02.VI.).

As such, one of ordinary skill in the art would not have been motivated to modify the telephone that is disclosed by the Gray reference based upon the disclosure in the Lim reference because the Lim reference operates based upon a principal of operation which is completely different from the devices that are disclosed by the Kfoury reference, the Narayanaswamy et al. reference, and the Gray reference.

Lastly, Applicant respectfully submits that, contrary to the Examiner's allegation, one

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of ordinary skill in the art would not have been motivated to modify the disclosure of the Gray reference based upon the disclosure of the Lim reference "in order to calculate the predetermined angle of the housing of [the] mobile phone when open or closed." (Emphasis added, Page 14, July 6, 2006, Office Action).

Indeed, the Lim reference does not teach or suggest that the joint which enables the telephone to achieve the claimed angles performs any calculations at all.

The Examiner refers to column 3, lines 28-31 in an attempt to support the Examiner's allegation that one of ordinary skill in the art would have been motivated to make the alleged modification "in order to calculate the predetermined angle."

However, contrary to the Examiner's allegations, the Lim reference does not teach calculating any angle at all.

Column 3, lines 28 - 31 state:

"open/close position.

This causes the folder 120 not to be opened/closed completely or to be open over a predetermined open angle of 150° in a manual operation mode."

This portion of the Lim reference is referring to what happens if "the folder 120 is held by the hand during the automatic opening/closing of the folder 120, or if an external force acts on the folder 120 due to a faulty manipulation of the switch in a state that the cellular phone is pocketed." (Column 3, lines 23-26).

Clearly, contrary to the Examiner's allegations, column 3, lines 28-31 of the Lim reference does not teach or suggest calculating anything at all, let alone calculating a predetermined angle.

Thus, contrary to the Examiner's allegations, one of ordinary skill in the art would not

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have been motivated to modify the Gray reference based upon the Lim reference "in order to calculate the predetermined angle."

Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 17.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 1-6, 8-18, and 20-22, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,


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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that I am filing this Request for Reconsideration by facsimile with the United States Patent and Trademark Office to Examiner Tuan Pham, Group Art Unit 2618 at fax number (571) 273-8300 this 6th day of September, 2006.


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